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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,562	07/11/2001	Aviv Ashkenazi	10466/51	1139

30313 7590 10/03/2002

KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

DEBERRY, REGINA M

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 10/03/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,562

Applicant(s)

ASHKENAZI ET AL.

Examiner

Regina M. DeBerry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39 and 44 is/are rejected.
- 7) ☒ Claim(s) 40-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z . | 6) <input type="checkbox"/> Other: _____ |

Status of Application, Amendments and/or Claims

The amendment filed 11 July 2001 has been entered in full. Claims 1-38 were cancelled. New claims 39-44 were added. The amendment filed 27 August 2002 has been entered in full. The information disclosure statement filed 14 March 2002 was received. It has been placed in the application file and the information referred to therein has been considered as to the merits.

Priority

According to the priority statement it appears that the claimed subject matter defined in the instant application is supported by US Provisional Application 60/059184 filed 9/17/97. Based on the information given by Applicant and an inspection of the parent applications, the Examiner has concluded that the subject matter defined in this application is supported by the disclosure in PCT application serial number PCT/US98/19330 filed 9/16/98 but is not supported by the US Provisional Application 60/059184 filed 9/17/97. Provisional 60/059184 does not teach how to use instant antibody and thus does not provide an enabling disclosure. Accordingly, the subject matter defined in claims 39-44 has an effective date of 9/16/98.

Should the Applicant disagree with the Examiner's factual determination above, it is incumbent upon the Applicant to provide the serial number and specific page number(s) of any parent application filed prior to 9/16/98 which specifically supports the particular claim limitation for each and every claim limitation in all of the pending claims

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which Applicant considers to have been in possession of and fully enabled for prior to 9/16/98.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. This occurs on pages 69, 71, 147, 154, 167 and 178. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 39 and 44 are indefinite because absent a definition of "specific binding" it is not clear what the difference between the two claims is and what each claim is meant to encompass, given that antibody binding is determined by the variable regions structure and is a "specific" event.

Claim Objections

Claims 40-43 are objected to because they depend from a rejected claim.

Art of Interest

The art made of record and not relied upon is considered pertinent to applicant's disclosure. Kato *et al.*, WO 99/43802, teach a polypeptide sequence that is 100% identical to SEQ ID NO:127 claimed in the instant application. Please see sequence query Appendix A. Kato teaches that the proteins can be employed as antigens from preparing antibodies against the proteins. Please see Kato reference, page 1, lines 10-12 and page 11, lines 25-31.

Conclusion

No claims are allowed.

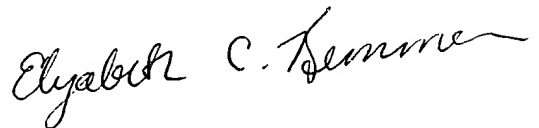
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina M. DeBerry whose telephone number is (703) 305-6915. The examiner can normally be reached on Mondays-Fridays 8:00 a.m. - 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (703) 308-4623. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



RMD
September 25, 2002



ELIZABETH KEMMERER
PRIMARY EXAMINER